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09/950,087	09/10/2001	P. Hamilton Clark III	D/A1322 (1508/3380)	2257
<div>7590 12/15/2008</div> <div>Gunnar G. Leinberg, Esq. Nixon Peabody LLP, Clinton Square P.O. Box 31051 Rochester, NY 14603-1051</div>				
EXAMINER				
LOFTIS, JOHNNA RONEE				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/950,087

Filing Date: September 10, 2001

Appellant(s): CLARK ET AL.

John F. Guay
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/24/07 appealing from the Office action mailed 7/12/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-6 and 19-22 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be performed without the use of a particular apparatus. Thus, claims 1-6 and 19-22 are non-statutory since they may be performed within the human mind.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5301320

MCATEE et al

4-1994

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

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Here, applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be performed without the use of a particular apparatus. Thus, claims 1-6 and 19-22 are non-statutory since they may be performed within the human mind.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 7-11, 13-17, 19-21, 23-25 and 27-29 are rejected under 35 U.S.C. 102(b) as being anticipated by McAtee et al, US 5,301,320.

As per **claim 1**, McAtee et al teaches creating at least one phase for the project (column 5, lines 25-30 – the business operations are broken down into goals each representing a business activity and further decomposed into the tasks necessary for its accomplishment); identifying which of one or more stored exit criteria are applicable to at least one of the phases of the project (column 5, lines 25-30 – the business operations are broken down into goals each representing a business activity and further decomposed into the tasks necessary for its accomplishment and column 7, lines 17-33 – each goal specifies criteria and when that goal is accomplished, the project can move on to the next task); establishing the identified one or more stored exit criteria for the at least one phase, the one or more exit criteria based at least partially on experience gained from one or more prior projects (column 5, lines 43-50 – goals are determined by the designer, stemming from a variety of considerations, inherently the goal would reflect criteria known from past experience so the tasks are completed successfully); determining whether each of the identified one or more stored exit criteria have been satisfied for the at least one phase

(column 7, lines 17-33 – each goal specifies criteria and when that goal is accomplished, the project can move on to the next task); and advancing the project to a next one of the phases based on the determination of whether each of the identified one or more stored exit criteria have been satisfied for the at least one phase (column 7, lines 17-33 – each goal specifies criteria and when that goal is accomplished, the project can move on to the next task).

As per **claim 2**, McAtee et al teaches modifying one or more of the identified one or more stored exit criteria to accommodate for project requirements (column 5, lines 43-50 - the designer can alter the goals to shift the relationship of the tasks to ensure the tasks are completed).

As per **claim 3**, McAtee et al teaches enabling the project to advance if the determination indicates that at least one of the identified one or more exit criteria have been satisfied (column 7, lines 17-33 – each goal specifies criteria and when that goal is accomplished, the project can move on to the next task).

As per **claim 4**, McAtee et al teaches tracking one or more problems noted for the project (column 8, lines 31-37 – status of the project is tracked, an idle condition indicates the project has been interrupted, inherently this interruption could be due to a problem or alteration).

As per **claim 5**, McAtee et al teaches monitoring progress of portions of the at least one phase of the project related to the identified one or more stored exit criteria (column 8, lines 17-30 – status of the goals are monitored); and determining if the portions related to the identified one or more stored exit criteria have been performed, wherein the enabling is also based on the determining if the portions related to the identified one or more stored exit criteria have been

performed (column 7, lines 17-33 – each goal specifies criteria and when that goal is accomplished, the project can move on to the next task).

Claims 7-11 are directed to the project management system for performing the method of claims 1-6, therefore, the same rejections as applied to claims 1-6 are also applied to claims 7-12 since McAtee et al teaches a computer system.

Claims 13-17 are directed to the computer readable medium with instructions to perform the method of claims 1-6, therefore the same rejections as applied to claims 1-6 are also applied to claims 13-18 since McAtee et al teaches a computer system

As per **claim 19**, McAtee et al teaches identifying one or more project requirements (column 5, lines 25-30 – the business operations are broken down into goals each representing a business activity and further decomposed into the tasks necessary for its accomplishment); creating a project strategy (column 5, lines 25-30 – the business operations are broken down into goals each representing a business activity and further decomposed into the tasks necessary for its accomplishment); defining a time schedule based on the project strategy (column 6, lines 42-45 – time restrictions are set); identifying and creating one or more project phases within the project (column 5, lines 25-30 – the business operations are broken down into goals each representing a business activity and further decomposed into the tasks necessary for its accomplishment); integrating the one or more phases with the time schedule (column 6, lines 42-45 – time restrictions are set for the goals); identifying which of one or more stored exit criteria are applicable to at least one of the phases of the project (column 5, lines 43-50 – goals are determined by the designer, stemming from a variety of considerations); establishing the identified one or more stored exit criteria for the at least one phase (column 5, lines 43-50 –

goals are determined by the designer, stemming from a variety of considerations); determining whether each of the identified one or more stored exit criteria have been satisfied for the at least one phase (column 7, lines 17-33 – each goal specifies criteria and when that goal is accomplished, the project can move on to the next task); and implementing the project by advancing the project to a next one of the phases based on the determination of whether each of the identified one or more stored exit criteria have been satisfied for the at least one phase (column 7, lines 17-33 – each goal specifies criteria and when that goal is accomplished, the project can move on to the next task).

As per **claim 20**, McAtee et al teaches basing the one or more exit criteria at least partially on experience gained from one or more prior projects (column 5, lines 43-50 – goals are determined by the designer, stemming from a variety of considerations, inherently the goal would reflect criteria known from past experience so the tasks are completed successfully).

As per **claim 21**, McAtee et al teaches tracking one or more problems noted for the project (column 8, lines 31-37 – status of the project is tracked, an idle condition indicates the project has been interrupted, inherently this interruption could be due to a problem or alteration).

Claims 23-25 are directed to the project management system for performing the method of claims 19-22, therefore, the same rejections as applied to claims 19-22 are also applied to claims 23-26 since McAtee et al teaches a computer system.

Claims 27-29 are directed to the computer readable medium with instructions to perform the method of claims 19-22, therefore the same rejections as applied to claims 19-22 are also applied to claims 27-30 since McAtee et al teaches a computer system

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 12, 18, 22, 26 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over McAtee et al, US 5,301,320.

As per claims 6, 12, 18, 22, 26 and 30, McAtee et al does not explicitly teach making information regarding the project accessible through at least one Web page provided to one or more project participants, the information being accessible to each of the project participants depending on their role in the project. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to automate the manual process shown in McAtee et al and modify it to include accessing information over the Internet; because the advantage accessing the information over the Internet allows project participants to access project data anywhere in the world that has access to the Internet.

(10) Response to Argument

Applicant's arguments, with respect to rejections under 35 USC 102 (b) have been fully considered but they are not persuasive. Applicant argues that McAtee et al does not teach identifying one or more stored exit criteria that are applicable to at least one of the phases of a project. However, Examiner points to column 6, lines 1-61, wherein it is taught that the user interacts with the manager utility to generate a database of workflow descriptions that includes goals, relationships among goals and characteristics associated with each goal. These are

processed during system operation to implement the workflow. Once the goals and goal information are entered into the workflow definitions database, the user creates the computer programs that carry out the tasks. Therefore, relating to the claims, a user creates a phase, or workflow, by determining which of the stored goals are applicable; next, entering each applicable goal creates the workflow. Then the workflow is carried out wherein the process is advanced only after completion of the goals in sequential order.

See table 1 in column 7 wherein partial data structures are shown for stored goals. Also see column 8, lines 38-44, here templates are discussed wherein it is taught that each goal contained in a template is assigned a unique identification sequence or number and goal information is retrieved as necessary from the goal database during processing, i.e., a template is created for a workflow, wherein each the goal that must be processed, or exit criteria, is determined and retrieved as the workflow is processed. The goal information is entered into a data structure, stored and later used to create various computer programs that facilitate or actually carry out the tasks. Since each goal, reflecting criteria that must be met prior to moving on to the next task, is entered, stored and later retrieved when executing a workflow (see column 9, lines 21-66), the user is accessing "stored exit criteria", or goal data, that must be accomplished prior to completion.

In response to Applicant's arguments regarding previous rejections under 35 USC 103(a), Examiner respectfully disagrees. Applicant argues that making the information accessible through a web page is not an obvious modification of the McAtee et al reference. Examiner points to *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958), wherein it was known at the time of the invention that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art. Modifying McAtee et al to include accessibility over the internet would have been obvious to one of ordinary skill in the art at the time of the invention because of the well known advantage of communicating information over the internet allows users to access data from anywhere in the world that has access to the Internet.

In light of recent Supreme Court precedent and recent Federal Circuit decisions, the claims warrant new rejections under 35 USC 101. These rejections are presented below.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Johnna R Loftis/

Examiner, Art Unit 3624

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Wynn W. Coggins/

Director, TC 3600

Conferees:

/Vincent Millin/

Appeals Practice Specialist

/Bradley B Bayat/

Supervisory Patent Examiner, Art Unit 3624